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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,916	03/31/2004	Masakazu Takahashi	251165US0	5710

22850 7590 01/24/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/812,916

Applicant(s)

TAKAHASHI ET AL.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The amendments of claims 1 and 4-7, the withdrawal of claims 8-13 and the addition of new claims 14-20, filed November 1, 2006, have been received and entered in full. It is noted that claim 11 is not cited as being withdrawn; however, as cited in the previous Office Action mailed August 10, 2006 this claim is withdrawn from consideration as being drawn to a nonelected group (see page 2, paragraph # 2).
2. Claims 1-7 and 14-20 are under examination.

Response to Arguments

3. Applicant's arguments, see 'Remarks', page 8, 5th paragraph, filed November 1, 2006, with respect to the 35 USC § 102 (b) rejection of claims 1-7 as being anticipated by Hajika et al on pages 7-8 of the Office Action mailed August 10, 2006 have been fully considered and are persuasive. The rejection has been withdrawn.
4. Applicant's arguments, see 'Remarks', page 9, 1st full paragraph, filed November 1, 2006, with respect to the 35 USC § 102 (b) rejection of claims 1-7 as being anticipated by Ogawa et al on page 8 of the Office Action mailed August 10, 2006 have been fully considered and are persuasive. The rejection has been withdrawn.

Claim Rejections - 35 USC § 112, first paragraph – Written Description

5. Claims 1-7 remain rejected and new claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

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such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 10, 2006, as applied to claims 1-7 (see pages 2-4). Applicant's arguments, filed November 1, 2006, have been fully considered but they are not persuasive.

Applicant argues that the structure of the soybean glycinin genes is known (see page 8, 1st paragraph of 'Remarks' filed November 1, 2006).

This is not persuasive. The rejection is not based on the description of the soybean glycinin genes, but the lack of description regarding the broad genus of soybean seed having the claimed characteristics. As stated in the previous Office Action mailed August 10, 2006, the specification only provides adequate written description for soybean lines QF2F₃-1, QF2F₃-2 and QF2F₃-3 (see page 3, 2nd full paragraph).

Applicant argues that the structure of the *Scg* gene corresponding to the β -conglycinin activity is knowable from the deposited microorganism *Glycine soja* GT2 (see page 8, 2nd paragraph of 'Remarks' filed November 1, 2006).

This is not persuasive. The rejection is not based on the structure of the *Scg* gene corresponding to the β -conglycinin activity, but the lack of description regarding the broad genus of soybean seed having the claimed characteristics. As stated in the previous Office Action mailed August 10, 2006, the specification only provides adequate written description for soybean lines QF2F₃-1, QF2F₃-2 and QF2F₃-3 (see page 3, 2nd full paragraph).

Applicant argues that the soybean lines are described in the specification (see page 8, 3rd paragraph of 'Remarks' filed November 1, 2006).

This is not persuasive. As stated in the previous Office Action mailed August 10, 2006, the specification only provides adequate written description for soybean lines QF2F₃-1, QF2F₃-2 and QF2F₃-3 (see page 3, 2nd full paragraph).

Claim Rejections - 35 USC § 112, first paragraph - Enablement

6. Claims 1-7 remain rejected and new claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 10, 2006, as applied to claims 1-7 (see pages 5-7). Applicant's arguments, filed November 1, 2006, have been fully considered but they are not persuasive.

In the 'Remarks' filed November 1, 2006 Applicant's arguments regarding rejections under 35 USC 112, first paragraph with regards to lack of enablement were grouped with the arguments for lack of written description (see page 7, last two lines to page 8, end of 4th paragraph). With regards to Applicant's arguments, as stated above, the Examiner maintains the rejection as set forth in the previous Office Action mailed August 10, 2006, namely that the specification does not provide enablement for the broad genus of soybean seed having the claimed characteristics, only for soybean lines

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QF2F₃-1, QF2F₃-2 and QF2F₃-3 (see page 5, paragraph # 5). Thus, Applicant's arguments, as stated above, do not overcome the enablement rejection.

Conclusion

7. No claims are allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grünberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

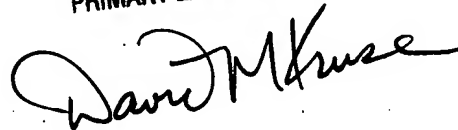
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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.

January 11, 2007

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.